

### **REMARKS/ARGUMENTS**

These remarks are submitted in response to the Office Action dated October 10, 2006 (hereinafter Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Office is expressly authorized to charge any deficiencies or credit any overpayments to Deposit Account 50-0951.

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,732,176 to Stewart, *et al.* (hereinafter Stewart), in view of U.S. Published Patent Application No. 2003/0096633 to Goldberg (hereinafter Goldberg), and further in view of U.S. Patent No. 6,954,735 to Djupsjobacka, *et al.* (hereinafter Djupsjobacka). Claims 1, 5, 9, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart, in view of Goldberg, and further in view of Djupsjobacka.

Claim 1 also was rejected under 35 U.S.C. § 112, second paragraph, for lack of proper antecedent basis. Applicants have amended the claim to correct the deficiency in accordance with the Examiner's suggestion.

#### **Applicants' Invention Predates Goldberg**

Applicants respectfully disagree that the references, even when combined, teach or suggest every feature recited in the claims. Applicants assert more fundamentally, however, that these issues are moot because Applicants' invention predates the May 13, 2000, effective date of the newly-cited reference, Goldberg.

Applicants conceived of their invention at least as early as January 18, 2000 and actively pursued its reduction to practice from a date prior to the effective date of Goldberg. In support of their assertion, Applicants submit the Declarations attached hereto in accordance with 37 CFR § 1.131. The Declarations establish conception and

continuing diligence from a time prior to the effective date of Goldberg to the filing of the Application.

Along with the Declaration, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC8-2000-0003, entitled *Multi-tier ASP/Software Delivery for Wireless Devices* (hereinafter Disclosure). The Disclosure was submitted on January 18, 2000, by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention, International Business Machines Corporation (IBM). The Disclosure was insubstantially modified on January 26, 2000. The description of the invention itself, however, was not modified after the Disclosure was initially submitted. Indeed, as noted below, established IBM procedures for handling all such disclosures preclude any modification to the description of the invention once it has been submitted by an inventor. The Disclosure has not been revised subsequent to January 26, 2000.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as January 18, 2000.

The Disclosure is an IBM confidential disclosure form. As such, it is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to

ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from prior to the effective date of Goldberg to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants from at least January 18, 2000, through the filing of the Application on August 6, 2001, worked diligently toward a constructive reduction to practice of the invention. Applicants initially worked with IBM's own in-house IP professionals during an internal review of the invention, including assessing the invention in the context of related literature. Subsequently, Applicants worked with outside counsel retained by IBM to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

Evidence of Applicants' due diligence is submitted herewith in the form of various correspondence between Applicants, IBM IP professionals, and outside counsel. The correspondence evince specific activities on specific dates, all relating to Applicants' pursuit of a constructive reduction to practice from a time prior to the effective date of Goldberg.

The correspondence includes a July 26, 2000 correspondence from IBM to outside counsel instructing the preparation and filing of co-pending Application No. 09/803,256. The correspondence also includes a subsequent E-mail from Applicants' support staff regarding the scheduling of a meeting with outside counsel for January 19, 2001; the e-mail is dated January 3, 2001. The Correspondence further includes a fax sent by outside counsel to the lead inventor on January 23, 2001 forwarding a draft of co-pending Application No. 09/803,256. Additionally, the correspondence includes a February 20,

2001 fax transmittal page indicating correspondence between the outside counsel and the lead inventor (forwarding a revised draft with formal documents for signing). The correspondence further includes a February 28, 2001 letter from in-house counsel at IBM responding to outside counsel's e-mail dated February 19, 2001 and supporting a decision to split the co-pending Application No. 09/803,256 into two filings. The correspondence also includes a July 26, 2001, letter and fax transmission sheet to the inventors submitting a draft application of the instant application for review. Lastly, the correspondence includes a July 27, 2001 letter and fax transmission sheet to the inventors submitting the final application and formal documents for their execution.

Applicants respectfully submit that it was reasonable for them to rely on outside counsel in preparing the Application, and that outside counsel acted with diligence, notwithstanding the constraints of other work obligations, in preparing the Application. Applicants further respectfully submit that the evidence of specific activity on specific dates clearly evinces Applicants prior conception and diligence in pursuing a reduction to practice from a time prior to the effective date of Goldberg.

**Certain Features Of Applicants' Invention Further Predate Stewart**

Stewart is cited at pages 3 and 4 of the Office Action as teaching two features of Applicants' invention. The first feature Stewart is asserted to teach is a short-range radio-frequency communications system. The second feature is the providing of Application Service Provider services that comprise a plurality of different software programs.

Applicants respectfully submit that the second feature, that of providing a plurality of different software programs, was not disclosed in the parent application of Stewart. Stewart, filed April 18, 2000, is a continuation-in-part of Application No. 09/433,818, which was filed on November 3, 1999 and issued as U.S. Patent No. 6,571,221 (hereinafter the '221 patent).

The '221 patent primarily discloses a communication system that includes both wired and wireless interfaces. (See, e.g., Col. 5, lines 29-46; Col. 6, lines 34-40; and Col. 6, line 62 – Col. 7, line 6; FIGS. 1A-C.) Although the '221 patent describes a system linking multiple service providers to subscribers, none of the service providers are described as providing a plurality of different software programs. Rather, as explicitly described, the service providers store and provide to subscribers various types of information, not different software programs. Such information includes demographic data and billing information, but not software programs:

"[T]he term "service provider" is intended to include various types of service and information providers which may be connected to the network. The service provider computer 140 may take any of various forms, and FIG. 3A is exemplary only. The service provider 140 may comprise a processor 310 coupled to a system bus 330. A database 325A and memory 320 may also be coupled to the system bus 330. System bus 330 is coupled to I/O bus 335. Network interface 340 may also be coupled to I/O bus 335. System bus 330 and I/O bus 335 may be coupled to other devices, such as a display.

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The processor 310 may use this sponsorship information in the digital certificate to access more detailed sponsorship information from a database (e.g., database 325A). The processor 310 may also access other information from the database (e.g., database 325A), such as demographic information and/or charging information. This information may be used, possibly in conjunction with geographic location information of the PCD, to provide targeted services or information (e.g., advertising information) to the mobile user. The service provider computer 140 may receive information or service requests from network 130, determine what information fulfills each request,

and make the information available to the network 130 through network interface 340.

"The database 325A [of a provider] may store various types of information, such as sponsorship information of the user, demographic information of users, charging information of the user, or other information. The database 325A may store user specific information relative to a specific MU or a groups of MUs. In one embodiment, a user's data may only be available to registered network users using an access code that has been approved by the MU. Alternatively, the database 325A may selectively store information received from a user, based on a permission received from the respective user. This information may be selectively provided by the service provider 140, possibly upon the approval of the MU. Thus the service provider 140 may act as an infomediary for MUs. (Col. 9, lines 23- 32; Col. 9, line 45 – Col. 10, line 5.) (Emphasis supplied.)

A similar service described in the '221 patent is termed a "digital certificate," which a service provider can provide to subscribers. The providing of such a certificate has nothing to do, however, with providing a plurality of different software programs. Instead, the service pertains only to providing certain types of information:

"The digital certificate may store information need for user authentication and security on the network.

"The digital certificate may also store various information, such as sponsorship information of the user. The sponsorship information may be stored in extensions within the digital certificate, such as non-critical extensions of the digital certificate. As noted above, the sponsorship information may include information regarding programs or entities in

which the mobile user is a member or is affiliated. For example, the sponsorship information may include information regarding frequent flier program memberships (e.g., the American Airlines Advantage Program), rental car incentive programs (e.g., Hertz Number One Club Gold), bank affiliations, country club affiliations, and other programs or affiliations, such as other incentive programs, preferred status memberships, other programs sponsored by vendors of goods or services, and other organizations of which the user is affiliated. The sponsorship information thus may take any of various forms.

"In one embodiment, the sponsorship information comprised in the digital certificate may comprise identifications or membership numbers for these various programs, e.g., the user's American Airlines Advantage Number, the user's Hertz Number One Club Gold ID #, and membership IDs for other programs or entities. The sponsorship information may also comprise references or cookies to more detailed sponsorship information, which may be kept on a separate server. The references or cookies may take the form of a URL, a pointer, an IP address, or other reference or cookie. Thus the sponsorship information comprised in the digital certificate may comprise only that information which changes infrequently, while providing valuable information on sponsorships or memberships of the user. The sponsorship information may also consume less memory space.

"In one embodiment, as noted above, more detailed sponsorship information may be stored on a separate database server. As one example, the digital certificate may store a user's American Airlines Advantage Number and a cookie or reference to a database which contains detailed information on the user's American Airlines Advantage membership, such as number of miles, expiration dates, travel itinerary history, etc. As another

example, the digital certificate may store a user's Hertz Number One Club Gold ID and a cookie or reference to a database which contains detailed information on the user's Hertz Number One Club Gold membership, such as rental car preferences, prior rental history, etc.

"The database server may also store personalized information or demographic information pertaining to the MU. In the present disclosure, the term "demographic information" of a user is intended to include, but is not limited to, information such as: full name, address, contact information such as telephone number and email address, daily schedule, family members, hobbies, past purchases, credit cards held, spending habits, buying preferences, hotel preferences, restaurant preferences, rental car preferences, banking habits, memberships (e.g., American Airlines Advantage Program, Hertz Number One Club Gold), associations, and other information. The term "past activities" may be used synonymously with the term "demographic information".

"The database server may also store charging information used for charging the MU for network access. The charging information may include information regarding participation in various incentive programs which may affect network access charging, e.g., programs which offer a limited time period of free or reduced charge network access. The charging information may also include information regarding an amount of available network access usage, e.g., a time amount, a dollar amount, or an amount of accrued "points". For example, the amount of "points" may indicate an amount of network usage available to the user.

"In an alternate embodiment, the demographic information and/or charging information, as well as the more detailed sponsorship information may be stored in the digital certificate itself. In general, the digital certificate



may include a wide variety of sponsorship, demographic, and charging information for a given user. In the preferred embodiment, the digital certificate stores information which changes infrequently, and may store references to one or more databases that contain data which changes more frequently." (Col. 11, line 29 – Col. 42.) (Emphasis Supplied.)

As described throughout the reference, the services provided with the system described in the '221 patent comprise providing, receiving, and storing different forms of information. Nowhere, though, does the '221 patent describe providing a plurality of different software programs.

Applicants respectfully submit, therefore, that whatever Stewart does or does not teach regarding the provision of a plurality of different software programs, this feature is not disclosed expressly or inherently in the parent of Stewart. Accordingly, at least with respect to the providing of different software programs, the effective date of Stewart is the filing date of the continuation-in-part application, April 18, 2000, not the filing date of the parent application.

Therefore, for the reasons already stated, Applicants conceived of the invention and pursued its constructive reduction to practice from a date prior to the effective date of Stewart. Accordingly, Applicants respectfully submit that their prior conception and diligence from a time prior to the effective dates of Stewart as well as Goldberg preclude the assertion of either reference against the claimed invention.

### CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

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Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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